

Application No.: 10/621,682

Docket No.: 65042-0431

REMARKS

Applicant has carefully reviewed the Office Action mailed September 28, 2005 and thanks Examiner Cronin for his detailed review of the pending claims and the indication of allowable subject matter indicating that claims 5, 7, 8, 29, and 32 would be patentable if rewritten in independent form. Claims 7 and 8 have been rewritten in independent form including the key limitations of original independent claim 1. Claims 29 and 32 have been rewritten in independent form including the key limitations of original independent claim 27.

Claims 1, 2, 6, 9, 11, 13 – 23, and 25 have been rejected under 35 U.S.C. 102(b) as being anticipated by Stapleton (U.S. Patent No. 5,016,799). Claims 3, 4, 12, 14, 24, and 26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Stapleton. Claims 10, 27, 28, 30, 31, and 33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Stapleton in view of Lumpe et al. (U.S. Patent No. 5,497,925).

Claim 1, 2, 3, 4, 7, 8, 15, and 27-33 have been amended. Claims 28, 30-31 and 33 have solely been amended to properly depend from independent claim 27. Accordingly, claims 1 – 33 are pending in this application. By way of this amendment, no new matter has been added. Applicant respectfully requests reconsideration of the present application in view of the above amendment and the following remarks.

I. Rejection of claims 1, 2, 6, 9, 11, 13 – 23, and 25 under §102(b)

Claims 1, 2, 6, 9, 11, 13 – 23, and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Stapleton (U.S. Patent No. 5,016,799). Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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Applicant notes that independent claim 1 has been amended to include a "support assembly for use with a vehicle article carrier comprising: a one-piece support having a base portion adapted to be selectively proximate a vehicle surface; and a rail portion remotely spaced from said base portion and said vehicle surface; a first attachment mechanism being associated with said support; and a cover, said cover having a second attachment mechanism engaging said first attachment mechanism to secure said cover to said support." In contrast, Stapleton teaches a stanchion 20 having a base member 26 with a "second end edge 40 from which the tongues 32 extend." *See col. 2, line 60.* Thus, Stapleton does not teach every limitation of amended independent claim 1, as required in *Verdegaal Bros.* Specifically, the tongues 32 extend from a second end edge 40 being aligned with base member 26 and not teaching "a rail portion remotely spaced from said base portion and said vehicle surface" as claimed.

Support for the newly added limitation can be found in at least paragraph [0021], and FIGS. 2 and 3. Specifically, paragraph [0021] recites: "The base portion 21 extends generally parallel to the vehicle surface with the upper rail portion 33 is spaced away from the base portion such that a rail 12 or 18 to be secured to the rail portion 33 is remotely spaced from the vehicle surface."

Accordingly, Stapleton does not teach or suggest the limitations as positively recited in independent claim 1. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection.

Furthermore, dependent claims 2 – 14 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, amended claim 2 recites "wherein said support includes a pair of sidewalls maintained in a spaced relationship by a web disposed therebetween, said sidewalls extending upwardly from said web, said sidewalls and said web defining said base portion and said rail portion." These teachings are not taught in the prior art of record.

Dependent claim 4 recites "wherein said rail portion includes an ear integral with said side wall, said ear being deformed into mating engagement with an adapter component to compressingly retain it within said support." These teachings are not taught in the prior art of record. First, Stapleton does not teach an ear being deformed into mating engagement. Second, Stapleton does not teach an ear integral with a side wall.

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Dependent claim 9 recites "wherein said sidewalls and said web define a channel and said cover substantially covers said support including closing said channel, thereby protecting said support from environmental conditions." These teachings are not taught in the prior art of record. Stapleton does not teach sidewalls and a web that define a channel.

Independent claim 15 recites a "support for use with a vehicle article carrier, said support in combination with other like supports maintaining at least one siderail or at least one crossrail in a spaced relationship from a surface of the vehicle, said support comprising: at least two substantially parallel sidewalls; a web extending between said sidewalls at a lower edge and maintaining said sidewalls in a spaced apart relationship; a first end of said support defining a base portion and a second end of said support defining a rail portion, said rail portion being remotely spaced from said base portion." These teachings are not taught in the prior art of record. Stapleton does not teach that a web extends between the sidewalls at a lower edge of the sidewalls. Further as stated above, Stapleton does not teach that the rail portion is remotely spaced from the base portion.

Dependent claim 23 recites "wherein said sidewalls define a plurality of openings for receiving male protrusions of a cover." These teachings are not taught in the prior art of record.

For at least these reasons, independent claims 1 and 15 are patentable over the cited references. Withdrawal of the rejection is respectfully requested. Dependent claims 2 – 14 are patentable by virtue of their dependency on patentable claim 1. Dependent claims 14 – 23 are patentable by virtue of their dependency on patentable claim 15. However, the dependent claims also contain additional limitations that are independently patentable as stated above. Withdrawal of the rejection is respectfully requested.

II. Rejection of claims 3, 4, 12, 14, 24, and 26 under §103(a)

Claims 3, 4, 12, 14, 24, and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Stapleton (U.S. Patent No. 5,016,799). Applicant respectfully traverses the rejection. The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of Stapleton to teach every element of independent claims 1 and 15 by not teaching "a rail portion being remotely spaced from said base portion" is also fatal to the Examiners §103 rejection.

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Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facia* obviousness as follows: "To establish a *prima facia case* of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

A patent claim is obvious, and thus invalid, when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; *see also Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *In re Dembiczaik*, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. *See Graham*, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some "suggestion, teaching, or motivation" that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). The Applicant(s) may rebut a *prima facie* showing of obviousness with evidence refuting the Examiner's case or with other objective evidence of nonobviousness. *See WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999).

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"The reason, suggestion, or motivation to combine [prior art references] may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest, or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to references relating to possible solutions to that problem.'" *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed.Cir. 2000) (quoting *Pro-Mold*, 75 F.3d at 1572). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references." *Dembiczak*, 175 F.3d at 999; see also *Ruiz*, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *Dembiczak*, 175 F.3d at 999. Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed*." (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir. 1998) ("In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*." (emphasis added)).

In this case, Stapleton does not teach a "a rail portion being remotely spaced from said base portion," and therefore, cannot make up for the inadequacy described above. Therefore, Stapleton does not teach every limitation of independent claims 1 and 15, as required in *In re Royka*. Accordingly, dependent claims, 1 – 14 and 16 – 26, being dependent upon independent claims 1 and 15 respectively, are patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

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III. Rejection of claims 10, 27, 28, 30, 31, and 33 under §103(a)

Claims 10, 27, 28, 30, 31, and 33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Stapleton (U.S. Patent No. 5,016,799) in view of Lumpe et al. (U.S. Patent No. 5,497,925). Applicant respectfully traverses the rejection. The remarks presented above with respect to the §102 rejection and the §103 rejection are equally applicable here. Specifically, the inadequacy of Stapleton to teach every element of amended independent claims 1, 15, and 27 by not teaching "a rail portion being remotely spaced from said base portion" is also fatal to the Examiners §103 rejection.

For at least the reasons stated above, independent claims 1, 15, and 27 are patentable over the cited references. Withdrawal of the rejection is respectfully requested. Dependent claims 2 – 14 are patentable by virtue of their dependency on patentable claim 1. Dependent claims 14 – 23 are patentable by virtue of their dependency on patentable claim 15. Dependent claims 28 – 33 are patentable by virtue of their dependency on patentable claim 27. However, the dependent claims also contain additional limitations that are independently patentable as stated above. Withdrawal of the rejection is respectfully requested.

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IV. Conclusion

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes that no fee is due with this response. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge account number 18-0013 in the name of Rader, Fishman & Grauer PLLC. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

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